

## REMARKS

Claims 1-19 are now pending in the present application. Reconsideration is respectfully requested in light of the amendments to the claims as well as the remarks below.

### REJECTIONS UNDER 35 U.S.C. §112:

Claims 3, 6, 9, 14 and 17 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Each of these claims has been amended to more clearly the subject matter as included therein.

Claims 10 and 18 were rejected under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 10 and 18 have been amended to more clearly define the elements as included therein.

### OBJECTIONS TO THE SPECIFICATION:

The specification was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. These rejections are now believed to be moot in view of the amendments noted above.

### OBJECTIONS THE DRAWINGS:

The drawings were objected to under 37 C.F.R. §1.83(a). These rejections are now believed to be moot in view of the amendments to the claims as noted above.

### OBJECTIONS UNDER 35 U.S.C. §103:

Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bayles, U.S. Patent No. 4,287,837 in view of Diamond et al., U.S. Patent No. 3,698,329. Claim 1 defines a privacy screen for use within a desk assembly having a worksurface

and an open span located above the worksurface that comprises, among other things, a first member and a second member, wherein the first member and the second member are telescopingly adjustable with respect to one another, thereby allowing adjustment of an overall length of the privacy screen extending between first and second ends thereof. The Bayles and Diamond et al. references as cited fail to teach, motivate, or suggest that which is defined in claim 1.

It is well established law that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Further, the mere fact that prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Moreover, the proper test for evaluating prior art under 35 U.S.C. §103 is whether or not the prior art, either individually or taken together, can be seen as suggesting the Applicant's solution to the problem which the invention addresses. *Rosemont, Inc. v. Beckman Industries, Inc.*, 732 F.2d 1540, 1546, 221, U.S.P.Q. 1, 7 (Fed. Cir. 1984). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references or the combination in the manner claimed. *In re Rouffet*, 42 U.S.P.Q.2d 1453,1458 (Fed. Cir. 1998). Finally, to imbue one of ordinary skill in the art with the knowledge of the invention, where no prior art

reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (citing *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983)).

The Examiner states that Bayles does not teach a telescopingly adjusting second portion of the privacy screen, and then cites Diamond et al. as teaching the necessary lacking elements. However, Diamond et al. teaches a horizontally-positioned wall mounted shelf assembly for use within a closet. The Applicant contends that no person of ordinary skill in the art would have sought to combine the teachings of a shelf system for use within a permanent closet structure with a desk as disclosed by Bayles. Further, Applicant can find no teaching, motivation or suggestion within any of the art as cited by the Examiner for the idea of utilizing a closet shelf for a privacy barrier. Moreover, it is suggested by the Examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Bayles by using a telescopingly adjusting panel as taught by Diamond et al. in order to allow the user to mount the panel on a diverse selection of desks with different span sizes. The only motivation the Applicant can find for providing an adjustable length privacy panel within a desk is located within the Applicant's own application. As noted above, such hindsight construction is improper. Therefore, claim 1 cannot be rendered obvious by that which is disclosed in Bayles and Diamond et al.

Accordingly, claim 1 is in condition for allowance. Claim 12 includes similar elements to those discussed above with respect to claim 1, and is therefore also in

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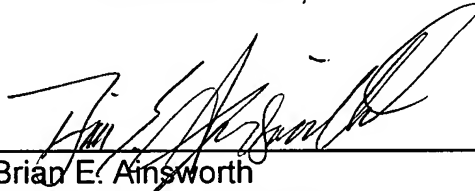
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condition for allowance for the same reason as set forth above with respect to claim 1. Claims 2-11 and 13-19 are dependent from claims 1 or 12, respectively, which are in condition for allowance, and are therefore also in condition for allowance.

Accordingly, Applicant now believes the application to be in condition for allowance, and a Notice of Allowability is earnestly solicited.

Respectfully submitted,

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